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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/679,209

10/02/2003

Wolfgang Wrasidlo

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06/05/2006

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EXAMINER

SAEED, KAMAL A

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/679,209

Applicant(s)

WRASIDLO ET AL.

Examiner

Kamal A. Saeed

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1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on communication filed on 3/9/06.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-100 and 103-141 is/are pending in the application.
4a) Of the above claim(s) 1-4, 6-62, 64-100, 115, 116 and 118-139 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) _____ is/are rejected.
7) ☒ Claim(s) 5, 63, 103-114, 117, 118, 140 and 141 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

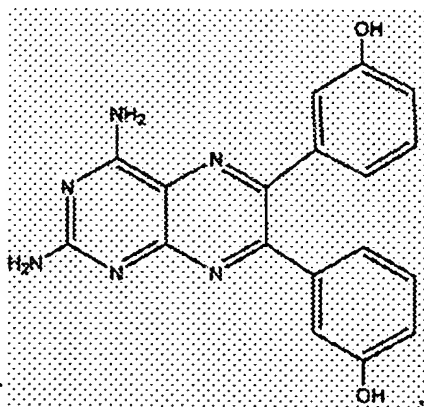
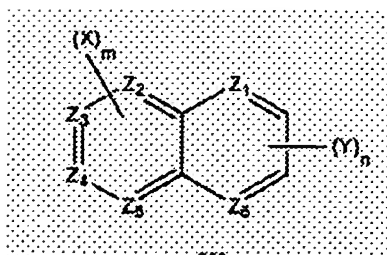
Claims 101 and 102 have been cancelled. Therefore, claims 1-100 and 103-141 are currently pending in this application. Claims 1-4, 6-62, 64-100, 115, 116, and 118-139 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

Information Disclosure Statement

Applicant's Information Disclosure Statements, filed on October 13, 2004 have been considered. Please refer to Applicant's copy of the 1449 submitted herewith.

Response to Restriction

Applicants' election with traverse of Group III, claims 5, 63, 103-114, 117, 118, 140 and 141 (all claims in part), drawn to the compounds represented by formula I,



..., and specific compound of
depicted on page 29 of the specification is acknowledged.

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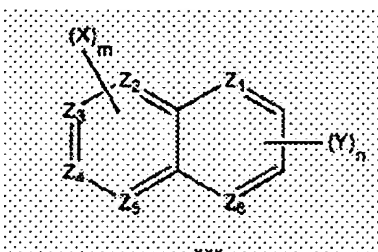
Applicant's arguments filed March 9, 2006 have been fully considered but they are not persuasive with respect to the restriction requirement. Applicants argue that the restriction requirement does not establish that searching all the inventions would constitute an undue burden to the Patent Office. Applicant also argues that in the case of an elected product claim, rejoinder is to be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Applicant traverses the restriction requirement if, once the elected species has been found to be allowable, examination is not expanded to generic claims encompassing the elected species. Applicant also argues that restricting the claims in the manner suggested in the restriction requirement constitutes an undue burden to Applicants as well as the public. The Examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) the claimed subject matter accordingly. For example, the claims encompass heteroaryl groups which are variously classified, therefore "heteroaryl" has been restricted out of the generic embodiment identified for examination. The following is an illustration of the varied classification of the heteroaryl groups: pyrazinyl is classified in class 544 and subclass 336+; pyrimidinyl is classified in class 544 and subclass 242+; pyridinyl is classified in class 546 and subclass 268.1+; oxazolyl is classified in class 548 and subclass 215+; thiazolyl is classified in class 548 and subclass 146+; etc. . . Thus, the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. No where to Applicants argue to the contrary. No where do Applicants point out and give reasons why the claims do not involve independent or distinct subject matter. Accordingly, the restriction is proper. Moreover, it would constitute a burden to

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extend the search because separate search considerations would be involved in both the U.S. Patents and in the literature. The examination process following the search could easily result in different and thus burdensome considerations.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The scope of the invention of the elected subject matter and examined is as follows:



Compounds of formula I, depicted in claim 1, wherein:

- (a) both Z_2 and Z_4 are C;
- (b) each of Z_1 , Z_3 , Z_5 , and Z_6 is N;

X and Y are as defined except that they don't represent a heterocyclic group; n and m are as defined.

As a result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claims 5, 63, 103-114, 117, 118, 140 and 141 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups such as triazine,

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homopiperaziny], thiomorpholinyl, propylaminyl etc, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 544 subclass 63(+) (thiomorpholine), class 540 subclass 450(+) (homopiperziny], class 544 subclass 180(+) (triazines), 548 subclass 400(+) pyrrolidines etc. Therefore the subject matter which are withdrawn from consideration as being non-elected subject differ materially in structure and composition and have been restricted properly a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

Objections

Claims 5, 63, 103-114, 117, 118, 140 and 141 are objected to for containing elected and non-elected subject matter.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed whose telephone number is (571) 272 0705. The examiner can normally be reached on M-F 8:00 AM- 5:00 PM.

The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272 0699. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.

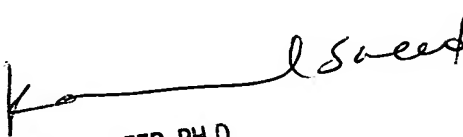
When filing a FAX in Technology Center 1600, please indicate the Header (upper right)

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“Official” for papers that are to be entered into the file, and “ Unofficial” for draft documents and other communications with the PTO that are not for entry into the file of the application.

This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.


KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER